

REMARKS

The Amendments

Claim 1 is amended to modify the definition of Y for formula I. Claim 9 is amended to rewrite it in independent form. Claim 20 is replaced with claim 21 which is previous claim 20 rewritten in independent form. Claim 9 (and claims 18-19 dependent thereon) and claim 20 were indicated to be allowable if rewritten in independent form. Dependent claims from the new independent claims which mirror some of the original dependent claims are added.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejection under 35 U.S.C. § 112, paragraph

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is believed rendered moot by the above amendment. The extraneous definition of "r" has been removed.

The Obviousness-type Double Patenting Rejections and Rejection under 35 U.S.C. § 102

The obviousness-type double patenting rejections of claims 1-5, 7 and 11-17 over claims 1-10 of U.S. Patent No. 5,919,396 (Tarumi '396) and over claims 1-10 of U.S. Patent

No. 6,080,452 (Tarumi '452) and the 35 U.S.C. § 102 rejection of claims 1-5, 7, 8 and 11-17 over Tarumi '396 are respectfully traversed.

Tarumi '452 is a divisional of Tarumi '396 containing the same disclosure. However, because of its later publication date, it is not 35 U.S.C. § 102(a) prior art. Neither Tarumi reference can be applied as prior art under 35 U.S.C. § 102(e)/103 against the instant claims because of 35 U.S.C. § 103(c) and the common assignment with the instant application, which was apparently recognized in the Office Action. It is noted that applicants' perfection of their priority date would also remove Tarumi '396 as prior art for 35 U.S.C. § 102(a)/103 purposes. However, it should be noted that a corresponding German application, DE19650634 A1 was published on October 6, 1998.

As to the substance of Tarumi, it is respectfully acknowledged that the subject matter of claims 9 and 18-20 was indicated to be allowable. These claims have been written in independent form and dependent claims thereon added. Thus, at the least, claims 9, 18-19, and 21-39 should be allowed.

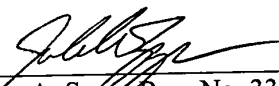
As to claim 1 and claims dependent thereon, this claim has been amended to distinguish the Tarumi disclosure and claims. The Tarumi references disclose compounds of the formula II therein (and LC compositions containing them) which compound II has a specific terminal fluorinated alkenyloxy group. Claim 1 has been amended to eliminate the recitation of halogenated alkenyloxy in the definition of the Y group for formula I. Thus, claim 1 does not encompass the formula II compound of Tarumi. Tarumi further does not disclose compounds meeting applicants' formula I of claim 1. The CCH formula in Table A, col. 10, provides a broad formula but the only CCH compounds actually disclosed are not fluorinated. Accordingly, Tarumi fails to anticipate any of the instant claims and the rejection under 35 U.S.C. § 102 should be withdrawn.

As to the obviousness-type double patenting rejections, there is no longer any overlap between applicants' formula I of claim 1 and formula II in the claims of both Tarumi patents. Thus, the double patenting rejection is believed to be removed.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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